

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09/781,042 02/09/2001		Sun Ming Lieu	020004-000710US	7563
20350 75	590 06/02/2005	EXAMINER		
	AND TOWNSEND AN CADERO CENTER	SMITH, JEFFREY A		
EIGHTH FLOO			ART UNIT	PAPER NUMBER
SAN FRANCIS	SCO, CA 94111-3834	3625		
			DATE MAILED 0/100/2004	_

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-		Application	n No	Applicant(s)	 		
Office Action Summary		09/781,04		LIEU ET AL.			
		Examiner		Art Unit			
	•	Jeffrey A.	Smith	3625			
	The MAILING DATE of this communicati		1		ldress		
Period fo				·			
THE I - Exter after - If the - If NO - Failu	ORTENED STATUTORY PERIOD FOR MAILING DATE OF THIS COMMUNICAT asions of time may be available under the provisions of 37 SIX (6) MONTHS from the mailing date of this communicate period for reply specified above is less than thirty (30) day period for reply is specified above, the maximum statutor reto reply within the set or extended period for reply will, be reply received by the Office later than three months after the patent term adjustment. See 37 CFR 1.704(b).	FION. CFR 1.136(a). In no evention. ys, a reply within the state y period will apply and within the state by statute, cause the apply	ent, however, may a reply be time story minimum of thirty (30) days Il expire SIX (6) MONTHS from lication to become ABANDONE	ely filed s will be considered timel the mailing date of this c O (35 U.S.C. § 133).			
Status							
1)⊠	Responsive to communication(s) filed or	n <u>20 September 2</u>	<u>004</u> .				
2a) <u></u> □	This action is FINAL . 2b)	☑ This action is n	on-final.		•		
3)[☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.						
Dispositi	on of Claims						
4)🖂	Claim(s) 1-65 is/are pending in the appli	cation.					
	4a) Of the above claim(s) is/are withdrawn from consideration.						
5)□	5) Claim(s) is/are allowed. 6) Claim(s) <u>1-65</u> is/are rejected.						
6)⊠							
	Claim(s) is/are objected to.						
8)[Claim(s) are subject to restriction	and/or election re	equirement.				
Applicati	on Papers						
9)[The specification is objected to by the Ex	aminer.					
10)🛛	☑ The drawing(s) filed on <u>09 February 2001</u> is/are: a)☑ accepted or b)☐ objected to by the Examiner.						
	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11)[The oath or declaration is objected to by	the Examiner. No	te the attached Office	Action or form P7	ГО-152.		
Priority u	ınder 35 U.S.C. § 119						
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage 							
+ 0	application from the International I	•	` ''				
* See the attached detailed Office action for a list of the certified copies not received.							
Attachma=	We\						
Attachment 1) Notice	e of References Cited (PTO-892)		4) Interview Summary	(PTO-413)			
2) Notice 3) Inform	e of Praftsperson's Patent Drawing Review (PTO-9 nation Disclosure Statement(s) (PTO-1449 or PTO r No(s)/Mail Date 5/26/04,5/12/05.		Paper No(s)/Mail Da		O-152)		
			-, -				

DETAILED ACTION

Response to Amendment

The response filed September 20, 2004 has been entered and considered.

Claims 1-65 are pending.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, \$8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. \$101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental

premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See Diamond v. Diehr, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See State Street Bank & Trust Co. v. Signature Financial Group, Inc. 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of

Patent Appeals and Interferences (BPAI). See In re Toma, 197
USPQ (BNA) 852 (CCPA 1978). In Toma, the court held that the
recited mathematical algorithm did not render the claim as a
whole non-statutory using the Freeman-Walter-Abele test as
applied to Gottschalk v. Benson, 409 U.S. 63, 175 USPQ (BNA) 673
(1972). Additionally, the court decided separately on the issue
of the "technological arts". The court developed a
"technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In Toma, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in State Street Bank & Trust Co. v. Signature

Financial Group, Inc. never addressed this prong of the test.

In State Street Bank & Trust Co., the court found that the

"mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See State Street Bank & Trust Co. at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under \$101, but rather under §§102, 103 and 112." See State Street Bank & Trust Co. at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, State Street abolished the Freeman-Walter-Abele test used in Toma. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in Toma because the invention in State Street (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the Toma test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and

Interferences (BPAI) in affirming a \$101 rejection finding the claimed invention to be non-statutory. See Ex parte Bowman, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, claims 1, 18, 19, and 20 do not recite a non-trivial application of "technology" in the bodies of these claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 9, 10, 12, 14, 15, 17, 20, 24, 25, 27, 32, 33, 35, 37, 38, 40, 43, 47, 48, 50, 55, 56, 58, 60, 61, and 63 are rejected under 35 U.S.C. 102(e) as being anticipated by Reynolds (U.S. Patent No. 5,905,991).

Reynolds discloses a method, system, and computer medium for providing information in response to an information request (col. 4, lines 3-14).

A target document contains at least one digital target token (904) which is a target document element being associated with at least one supplementary document. The supplementary document contains at least one digital supplementary token (906) which is associated with at least one digital target token. Either token may include, individually or in any combination, digitized characters, words, phrases, files, pages, sites, images or sounds. See col. 4, lines 53-63.

A given token may be identified in more than one coupling. See col. 6, lines 23-24. The associations through the configured couplings serve as sets of rules which identify a plurality of tokens and information associated therewith. See col. 6, lines 33-46. A target token may be assigned one or more couplings (a first set of rules) and a supplemental token may be assigned one or more couplings (a second set of rules). See col. 6, lines 23-47.

The target tokens are determined corresponding to a request for the target document and the supplementary information associated with the supplemental document may be communicated.

See col. 5, lines 32-45.

Preferences can be stored and the first information satisfying the preferences is filtered and communicated. See col. 7, lines 46-50.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 5-8, 11, 13, 16, 18, 19, 21-23, 26, 28-32, 34, 36, 39, 41, 42, 44-46, 49, 51-54, 57, 59, 62, 64, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds (U.S. Patent No. 5,905,991) in view of Furst (U.S. Patent No. 6,297,819 B1).

Reynolds does not disclose purchasable items or vendors.

Furst, however, in a similar method and system (col. 1, line 63-col. 2, line 4; col. 2, lines 58-62) that sales and marketing efforts may be brought to the context of a user-selected web site (col. 3, lines 7-10). Furst teaches that

notification conditions can be triggered by various user actions (col. 6, line 51-col. 7, line 7). One example is that a user may enter a URL request. Third parties, such as vendors, may designate the triggers which precipitate notification. See col. 7, lines 37-57. Contextual sales applications can thereby be offered to the user by a vendor (col. 10, line 55-col. 11, line 14). Comparative shopping and retail registry applications are also enabled. See col. 12, line 56-col. 13, line 15.

It would have been obvious to one of ordinary skill in the art to have employed the method, system, and computer medium incorporating the purchasable item and vendor aspects of Furst in order to have provided a combination which would have offered vendors sales and marketing opportunities and which would have also offered users the opportunity to find, compare, and purchase goods and services that they may be seeking in the context in which they are currently browsing (Furst: col. 3, lines 7-10).

Regarding claims 7, 8, 30, 53, and 54: It is noted that neither Reynolds or Furst disclose a quantity value or a unit of measure associated with the quantity value. However, each disclose character strings such as keywords, or phrases. It would have been obvious to one of ordinary skill in the art to have further specified values and units of measure associated

Application/Control Number: 09/781,042

Art Unit: 3625

with such values as such specification would have merely been one of the nearly infinite number of character strings which the skilled artisan would have viewed as being obvious for the purposes already taught.

Response to Arguments

Page 10

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Application/Control Number: 09/781,042 Page 11

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Deffrey A. Smith Primary Examiner Art Unit 3625

jas